

Dennis Bennett

636-207-5941

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| <b>To:</b> Commissioner of Patents    | <b>From:</b> Dennis Bennett       |
| <b>Fax:</b> 571.273-8300              | <b>Pages:</b> 4 (including cover) |
| <b>Phone:</b>                         | <b>Date:</b> 11/01/2006           |
| <b>Re:</b> Application No. 10/820,647 | <b>cc:</b>                        |

☐ **Urgent**    ☐ **For Review**    ☐ **Please Comment**    ☐ **Please Reply**    ☐ **Please Recycle**

◆ **Comments:** Attached herewith please find a response to Restriction/Election of Species.

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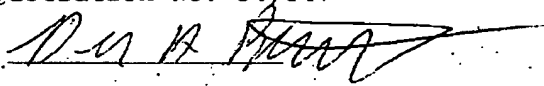
Case No. K0003-201-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: )  
Kevin Liu et. al. ) GROUP ART UNIT: 1624  
)  
)  
Application No.: 10/820,647 ) EXAMINER: Rao, Deepak  
)  
FILED: 04/07/2004 ) DATE: Nov 01, 2006  
TITLE: ARYL COMPOUNDS AS MODULATORS OF PPARS AND METHODS OF  
TREATING METABOLIC DISORDERS

VIA FACSIMILE: (571) 273-8300  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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Registration No. 34,547



REPLY TO REQUIREMENT FOR RESTRICTION AND ELECTION OF SPECIES

Sir:

This letter is in response to the Office Action dated  
October 03, 2006, having a Shortened Statutory Period for Reply  
that is set to expire on November 03, 2006.

Authorization is hereby given to treat this and any future  
reply, requiring a petition for an extension of time under 37 CFR  
§ 1.135 for its timely submission or payment of fee, as  
incorporating a petition for extension of time for the  
appropriate length of time or authorization to pay any required

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fees. Please charge any appropriate fees to Deposit Account No. 503299.

This action requires restriction under 35 U.S.C. 121 among groups I-IV. Applicant respectfully elects, with traverse, Group I, (Claims 1-70 drawn to compounds and methods of Formula I wherein AR<sub>1</sub> is pyrimidine). Applicant reserves the right to file divisional applications on the subject matter not elected under this response.

Applicant traverses the examiner's requirement for the restriction since the restriction is directed to subject matter all contained within the Markush claim itself. 35 USC 121 does not permit imposing a restriction requirement of subject matter contained within a single Markush claim. There is no authority for imposing a restriction requirement on a claim which effectively carves it up into the various subparts as has been required by the examiner. In re Weber 198 USPQ 328 (CCPA 1978) and In re Watkinson 14 U.S.P.Q. 2d 1407 (Fed. Cir. 1990).

In addition, M.P.E.P 803.02 advises the examiner that he should examine the Markush claim unless the subject matter in the claims lacks unity of invention. The presently claimed invention has unity of invention. The compounds of the present invention share a common utility of mediating disease by modulation of peroxisome proliferator activated receptors (PPARs). The compounds of the present invention share a substantial chemical feature as can be seen in the formula I.

In light of the above the rejection under 35 U.S.C. 121 is improper and should be withdrawn.

In response to the election of species requirement under 35 USC 121, applicants provisionally elect for search purposes only, the compound of Claim 50 (Example 7a ((3-{3-[(2,4-Bis-trifluoromethyl-benzyl)-(5-ethyl-pyrimidin-2-yl)-amino]-propoxy}-phenyl)-acetic acid)).

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Claims 1-4, 6-22, 26, 28, 32, 33, 36-40, 43, 44, 47, 48, 50-68 and 70 read upon the elected species.

For example the compound of claim 50 falls within the provisionally elected group I of claim 1 as follows:  
Ar<sub>1</sub> is a monocyclic heteroaromatic ring (provisionally elected as being pyrimidine as required by group I);  
Ar<sub>2</sub> is a monocyclic carbocyclic aryl ring;  
R<sub>1</sub> is alkyl substituted an optionally substituted carbocyclic ring;  
R<sub>2</sub> is alkyl;  
R<sub>3</sub> is hydrogen;  
B is (CH<sub>2</sub>)<sub>j</sub>-COOR<sub>4</sub>;  
j is 1; and  
R<sub>4</sub> is hydrogen.

It is respectfully submitted that the claims have been put in condition for allowance. Notification to this effect is earnestly solicited. The Examiner is encouraged to contact the Applicants' undersigned attorney to discuss this matter if any questions should arise upon further examination of the pending claims.

Respectfully submitted,

Nov 01 2006  
Date

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